



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/673,001 | 10/06/2000 | Robert Kroie | 2354/110 | 7390 |

7590

07/31/2002

Michael L Goldman
Nixon Peabody LLP
Clinton Square
PO Box 31051
Rochester, NY 14603

EXAMINER

GREEN, CHRISTY MARIE

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,001

Applicant(s)

KROIE, ROBERT

Examiner

Christy M Green

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-31, 33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-31, 33 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/00 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3635

DETAILED ACTION

This is a second office action for serial number 09/673001, entitled Paper Coated Metal Building Panel and Composite, filed on October 6, 2000.

Response to Amendment

In response to the examiner's office action dated December 28, 2001, the applicant has cancelled claim 32, added new claim 37 and amended the specification, abstract and claims 1, 2, 5-9, 19-21, 26 and 33.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reinforcing element (it is interpreted to be as defined as a reinforcing member as stated within the specification) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmon, US Patent # 4,186,539.

Harmon discloses the claimed invention including a building panel (10) and a reinforcing element (where 16 and 17 points to), the panel having spaced metal sheets (13, 14) interconnected by a core (15), the metal sheets defining opposite major surfaces of the panel (figure 1), each including opposite edge regions (11, 12) which form longitudinal edge regions of the panel (10), at least one of the edge regions of the metal sheets on both opposite edge regions of the panel is profiled *to form* connecting elements (the area where 20 and 23 points to) *adapted to* interfit with the connecting element of a respective one of the edge regions of [a like] **another** panel (figures 2-4), the panels arranged that the major surfaces (13, 14) of the panels are aligned in substantially abutting relationships *to form* a substantially continuous surface (figure 4); **in use, the reinforcing element (16,17) locates between each pair of interfitting connecting elements (the area where 20 and 23 points to) at the joint between the interconnected panels (10);** the connecting elements (the area where 20, 23 points to) are in the form of interfitting channels and projections **on opposite edges of panel** (figure 2), each channel (19) incorporating opposite walls (where 19a points to, and see attached figure 2) interconnected by a base portion (where 19 points to), and wherein each projection (what 18 points to) is shaped to interfit with the channel of [a like] **another** panel (figure 4) and includes opposite walls interconnected by a substantially flat apical portion, (where 10 points to), the reinforcing element (16, 17) includes at least one engagement part which is generally u-shaped (figure 2) and locates between a

Art Unit: 3635

interfitting channel and projection of the interconnected panels (within the area of where 26 points to); the reinforcing element includes spaced apart engagement parts (21) interconnected by a web (17); the opposite walls of each channel (where 19 points to) and projection (where 18 points to) merges with its base portion at approximately 90° to *form* a part box section (see attached figure 2); wherein the opposite walls of the channel include a re-entrant inner surface/portion and the opposite walls of the projection includes a crest on its outer surface (where 22 points to) – see attached figure 3, and they are both arranged to engage each other in a snap fit arrangement (figures 3-4); the connecting elements (the area where 20, 23 points to) are *adapted to* interfit with the connecting elements of [a like] **another** panel with the reinforcing element (16, 17) in a snap fit arrangement (figures 3-4); at least one abutment surface (what 18 points to) at each longitudinal edge region extending generally perpendicular to the major surface (13, 14) of the panel (10), each disposed between a major surface and the connecting element (figure 2); and, **the reinforcing element (18) is configured to be installed at a joint (where 19 points to) formed on the connection of one panel (10) having a connecting element (23) with another panel (10) having a connecting element (20) configured to interfit with the connecting element of the other panel (figure 4) and is secured in place by locating the reinforcement element between the pair of interfitting connecting elements at the joint between the interconnected panels (figure 3); except for the reinforcing element is separate.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the reinforcing element separate, since there is no criticality to the

integral?

Art Unit: 3635

part being separate, and since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art; also, the invention seems to work equally well with the reinforcing element being integral.

Claim 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanmartin et al., US patent # 4,937,125 in view of Kreckel et al., US patent # 5,536,778.

Sanmartin discloses the claimed invention a laminated building panel (figure 3) including a cellular and non-woven polyester covering (4,5,6) bonded directly onto a metal substrate (8) using a hot melt reactive adhesive (column 6, lines 30-31 and lines 39-48); and, the metal sheet is selected from the group of mild steel, aluminum, tin, stainless steel or galvanized steel (column 6, lines 33-35); except for the covering being of paper. Kreckel et al. Teaches that it is known in the art to provide a paper or sheet rock covering bonded to a stainless steel panel (column 9, lines 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the paper or sheet rock covering of Kreckel with the building panel of Sanmartin in order for the panel to be used within the interior walls of a building structure (column 10, lines 49-50).

Claims 1-12, 16, 28-31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmon in view of Sanmartin in further view of Kreckel.

Harmon discloses the claimed invention a building panel as stated above in claim 19, including a channel (19) that is generally c-shaped in cross-section (figure 2), the projection is also in the form of a channel (see the attached figure 2) and interfits in nesting engagement within the channel of [a like] **another** panel (figures 2-4), an outer

Art Unit: 3635

surface of the projection (where 22 points to), the inner surface of a shannel (where 19 points to), the major surface incorporates a recess (19a) adjacent its edge regions (where 16 and 17 points to) and, the metal sheets are interconnected by a core (2); except for a paper covering bonded directly to the substrate, the covering giving the surface a characteristic substantially the same as a plasterboard panel, the paper bonded to the metal using a reactive hot melt adhesive, a laminating process is used to adhere the paper to the metal sheets.

Sanmartin in view of Kreckel et al. teaches that it is known in the art to provide a building panel with a metal sheet (figure 1) and a paper covering (Kreckel - column 9, lines 51-55) bonded directly to the metal sheet "8" (Sanmartin - column 6, lines 30-31, 46-48 and 59-65), the covering giving the surface a characteristic substantially the same as a palsterboard panel (Sanmartin - column 1, lines 55-61; Kreckel – column 9, lines 57-60), a laminating process is used to adhere the paper to the metal sheets (Sanmartin - column 4, lines 27-34 and column 6, lines 46-48) and, the metal (3,8) is between 0.3 to 1mm (column 7, lines 27-28, column 5, lines 14-17).. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the building panel of Harmon with the teaching of a paper covering of a building panel of Sanmartin in view of Kreckel, in order to place the panel on the interior wall of a building (column 10, lines 49-50), add fire proofing qualities to the panel, to provide more tolerance to damage of the panel by impact, and prevent ageing (column 4, lines 53-57), to co-fuse the layers of the panel to prevent buckling (column 2, lines 9-10), and the

laminating process used to make the skin of the sandwiched panel resistant to shocks and thermal aggressions (column 2, lines 48-54).

Response to Arguments

Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection as above.

Applicant's arguments filed 5/9/02 have been fully considered but they are not persuasive.

In regards to the examiner not previously considering the references within the international search report, the listing of references in the specification or within the international search report of a PCT are not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."

Since there is was no formal information disclosure statement filed prior to 6/19/02, and because there was not a concise explanation of the relevance of these references within the international search report as it is presently understood by the examiner the information referred to therein was not been considered. If these references that the applicant is referring to are within the newly filed IDS, than they are considered by the examiner as attached.

In regards to the applicants argument that Harmon does not suggest a panel having a paper covering, the examiner recognizes the argument, however Harmon was used to show the basic limitations of the interconnecting panels and the Sanmartin

Art Unit: 3635

reference was used to teach that it is known in the art to disclose a paper covered building panel.

It should also be noted that within the above rejection, all of the bold face typing is in reference to the newly added limitations within the amended claims and the newly added claims and therefore any arguments based on the new limitations are addressed within the above rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy M Green whose telephone number is 703-308-9693. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


cg

July 23, 2002


Carl D. Friedman
Supervisory Patent Examiner
Group 3600

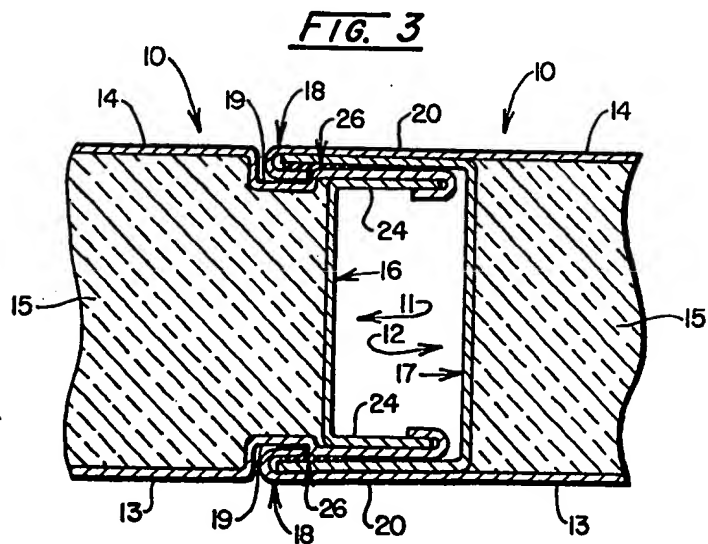
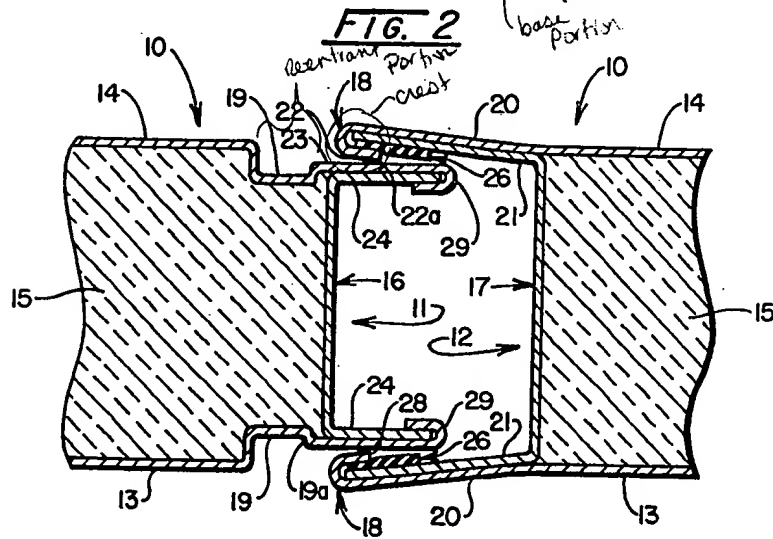
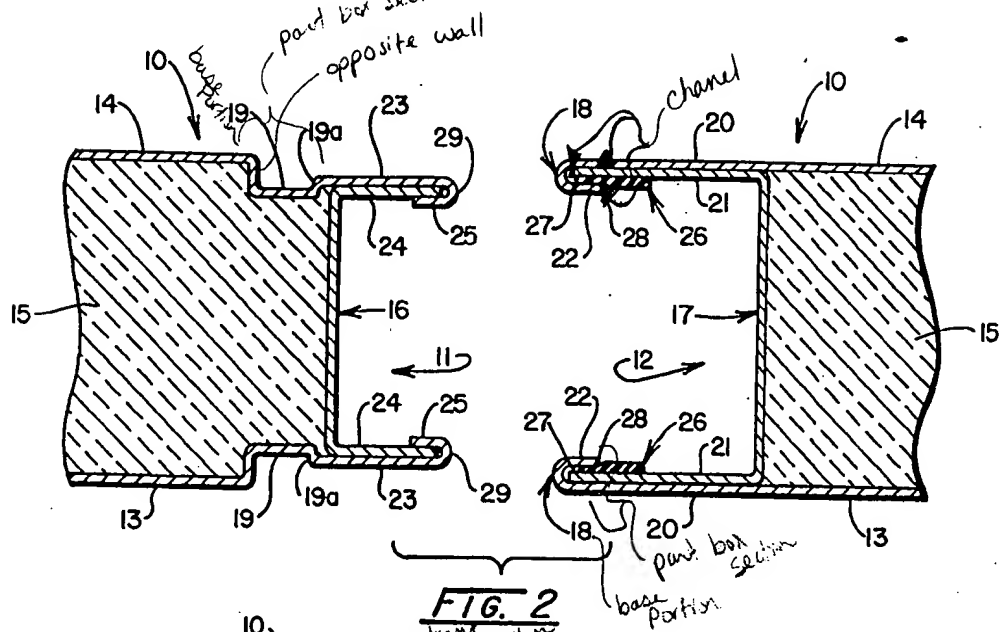


FIG. 4